REMARKS

I. Introduction

With the cancellation of claims 11 to 18, claims 1 to 10 and 19 to 21 are currently pending in this application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claim 21 Under 35 U.S.C. § 112, 1st ¶

Claim 21 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the Specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses this rejection and submits that claim 21 is allowable for the following reasons.

Applicant respectfully submits that the Office Action's present assertions and arguments reflect the subjective beliefs of the Examiner, and therefore simply do not reflect the proper standard for determining whether a patent application complies with the enablement requirement that the Specification describe how to make and use an invention that is defined by the claims. See M.P.E.P. § 2164 (even if a claim feature does "lack descriptive support in the disclosure," this does not mean that the feature is not enabled; a claim feature "in and of itself may enable one skilled in the art to make and use the claim containing" the claim feature).

This standard may not be based on the subjective beliefs of an examiner, but must be based on reasonable arguments that are supported by proper evidence. The Supreme Court established the appropriate standard as requiring the establishment by proper evidence of whether ***any experimentation for practicing the invention was undue or unreasonable***. See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988)). Thus, the enablement test is whether "one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art *without undue experimentation*." *See id.* (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has also stated that there are many factors to be considered in determining whether a specification satisfies the enablement requirement. These factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. *See id.* (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). The Federal Circuit has further stated that it is "*improper* to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that an examiner's analysis must "consider all the evidence related to each of these factors" so that any nonenablement conclusion "must be based on the evidence as a whole." See M.P.E.P. § 2164.01.

Moreover, to reject the claims as not being enabling, an examiner bears the initial burden of establishing exactly why the "scope of protection provided by a claim is not adequately enabled by the disclosure." *See id.* (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. *See id.*

In particular, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected, under the first paragraph of 35 U.S.C. § 112, application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law -- which makes plain that an examiner, and not an applicant, bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed

invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. *See id.* Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." *See id.* at 1222 & 1223 (emphasis in original). Here, it has not even been conclusorily asserted that undue experimentation would be required.

It is believed and respectfully submitted that a person of reasonable skill in the art could make or use the hydraulic bearing recited in claim 21 based on the Specification and Figures of the present application coupled with information known in the art without undue experimentation. See the Specification, for example, at p. 7, line 22 to p. 8, line 1. It is therefore respectfully submitted that claim 21 is fully supported by an enabling disclosure. The Office Action refers to the last line of page 7 of the Specification but provides absolutely no explanation as to the grounds of the rejection, let alone establishing exactly why the "scope of protection provided by a claim is not adequately enabled by the disclosure." M.P.E.P. § 2164.01 (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Withdrawal of this rejection is therefore respectfully requested.

III. Rejection of Claim 21 Under 35 U.S.C. § 112, 2nd ¶

Claim 21 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully submits that claim 21 is allowable for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a *reasonable* degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the "focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision." In this regard, the "essential inquiry pertaining to this requirement is whether

the claims set out and circumscribe a particular subject matter with a *reasonable* degree of clarity and particularity." *Id.* (emphasis added). "Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, *inter alia*, the] content of the particular application disclosure[and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

The Office Action alleges that the language "180 degrees out of phase with the induced vibration" is unclear. Applicant respectfully submits that use of the language "180 degrees out of phase with the induced vibration," is sufficiently clear and, therefore, fully complies with the definiteness requirement of 35 U.S.C. § 112. The claim language reasonably clearly communicates that damping fluid is just beginning to reverse directions in the damping channel when another vibration induces flow of the damping fluid, in a direction opposite to the returning flow of the damping fluid, whose movement was induced by an earlier vibration and which has already reversed directions. See p. 3, lines 26 to 32. Notwithstanding the above, claim 21 has been amended to recite that the hydraulic bearing is configured such that in response to low-frequency high amplitude vibrations in an axial direction of the hydraulic bearing the damping device has damping fluid flowing back and forth through it in phase opposition to the induced vibrations. Support for this amendment can be found, for example, at p. 3, lines 26 to 32 and p. 7, line 22 to p. 8, line 1. Applicant submits that it would have been reasonably clear to one skilled in the art that the damping effect of the present invention is based on the fact that the damping fluid inside the damping channel can move back and forth out of phase, preferably in phase opposition to the induced vibrations. See p. 3, lines 26 to 32. Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claims 1 to 10, 19 and 20 Under 35 U.S.C. § 102(b)

Claims 1 to 10, 19 and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,386,973 ("Brenner et al."). Applicant respectfully submits that Brenner et al. do not anticipate claims 1 to 10, 19 and 20 for the following reasons.

Claim 1 relates to a hydraulic bearing. Claim 1 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 1 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it. Claim 1 has been amended to recite that the damping device (6) is formed by a partition (7) between the working space (4) and the compensating space (5) and that the partition (7) has at least one radially extending damping channel (8). Support for this amendment can be found, for example, at p. 3, lines 26 to 32, p. 5, lines 15 to 17 and p. 7, line 22 to p. 8, line 1.

Brenner et al. purportedly relate to an elastomeric bearing. Brenner et al. state that the bearing includes at least two fastening parts 7 and 8 connected to one another by means of an elastomer spring 6. Inside the elastomeric bearing at least two damping devices are stated to work essentially independent of one another. See col. 4, lines 4 to 12. The first independent damping device is stated to include chambers 3a and 3b, which are stated to communicate via passage 4. The second independent damping device is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. The first independent damping device is stated to dampen in the radial direction and the second independent damping device is stated to dampen in the longitudinal direction. See col. 4, lines 17 to 40. Accordingly, fluid only flows through partition 10 (damping device) in the second damping device when parts 7 or 8 are excited in a longitudinal direction. Axially extending opening 15 is stated to be provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. To achieve a proper pressure equalization, an evacuation hole 14 is stated to be provided in the protective cap 13 to

allow atmospheric pressure to act on the external side of chamber 1b. See col. 4, lines 64 to 68.

Brenner et al. do not disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Further, nowhere do Brenner et al. disclose, or even suggest, a damping device formed by a partition between the working space and the compensating space having at least one ***radially extending*** damping channel. As shown in Figure 1, opening 15 ***extends axially*** between passages 1a and 4. Therefore, Brenner et al. do not disclose all of the limitations of claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Brenner et al. do not disclose, or even suggest, a working space and a compensating space that are each filled with a damping fluid and communicate through a damping device, having a ***radially extending*** damping channel, in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Further, Brenner et al. would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Therefore, it is respectfully submitted that Brenner et al. do not anticipate claim 1.

Brenner et al. state that opening 15 is provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. Respectfully, nowhere does Brenner et al. state, or even suggest, that relative ***radial displacement*** of Brenner et al.'s journal bearing and supporting bearing with respect to one another *necessarily* results in a pressure differential between the working space and the compensating space which *necessarily* causes fluid to flow between these

spaces. Relative radial displacement of the journal and supporting bearings may simply cause fluid to shift from cavity 3a to communicating cavity 3b via passage 4, which is larger than opening 15, (see col. 4, lines 23 to 25) and the referred to pressure equalization may only occur, for example, upon relative longitudinal displacement of the bearings or upon opening evacuation hole 14. As indicated above, to achieve a proper pressure equalization, there can be an evacuation hole 14 in the protective cap 13 to thereby allow atmospheric pressure to act on the external side of chamber 1b. See col. 4, lines 64 to 68.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." *See* M.P.E.P. § 2112; emphasis in original; and *see, Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Nowhere does the Examiner rely on technical reasoning to support its conclusion that fluid necessarily flows between passages 1a and 4 in response to a relative radial displacement of the first and second independent damping devices. As indicated above, Brenner et al. merely disclose pressure equalization through opening 15 and not, specifically, fluid flow in response to a relative radial displacement of the journal and supporting bearings, as recited in claim 1. See col. 10, lines 22 to 26. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

The Office Action alleges that Applicant's argumentation relies on a feature not recited in the rejected claims. Respectfully, Applicant does not rely on the word "necessarily" because it is in the claims but rather in its arguments regarding inherency. Applicant states outright that Brenner et al. do not disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. There is no mention of the word "necessarily" in this argumentation. However, in response to the Examiner's argumentation that Brenner et al. inherently discloses the above recited feature of claim 1 because pressure equalization allegedly leads to fluid flow through opening 15, Applicant argues

that radial displacement of the journal and supporting bearing does not *necessarily* lead to flow through opening 15, and therefore, Brenner et al. cannot be relied upon in this manner. As indicated above, relative radial displacement of the journal and supporting bearings may simply cause fluid to shift from cavity 3a to communicating cavity 3b via passage 4, which is larger than opening 15, (see col. 4, lines 23 to 25) and the referred to pressure equalization may only occur, for example, upon relative longitudinal displacement of the bearings or upon opening evacuation hole 14. As further indicated above, to achieve a proper pressure equalization, there can be an evacuation hole 14 in the protective cap 13 to thereby allow atmospheric pressure to act on the external side of chamber 1b. See col. 4, lines 64 to 68. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 1 is respectfully requested.

As for claims 2 to 10, 19 and 20 which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 10, 19 and 20 are respectfully requested.

In regard to claims 2, 4, 6, 9 and 20, Applicant respectfully submits the following additional reason in support of patentability. Nowhere do Brenner et al. disclose, or even suggest, a spiral shaped radially extending channel, as recited in claim 2. As indicated above, opening 15, as shown in Figure 1, ***extends axially*** between passages 1a and 4. Therefore, withdrawal of the rejection of claims 2, 4, 6, 9 and 20 for at least this additional reason is respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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By: _____

Abraham P. Ronai
Reg. No. 41,275

One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646